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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,433	07/14/2000	Shoji Yasuda	2870-0137P	5348

7590 10/21/2003

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EXAMINER	
CHEA, THORL	
ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/617,433	YASUDA, SHOJI	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2003 and 18 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-16* is/are pending in the application.

4a) Of the above claim(s) *11-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 3-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1 and 3-16* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. Newly submitted claims 11-16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The invention of claims 1-10 are directed to the an article classified in class 430/619 and the invention of claims 11-16 are directed to fatty acid salt grains and the process for forming thereof classified in class 554/74. Inventions of claims 1-10 and claims 11-16 are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as useful in the production of heat detective material and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-16 are withdrawn from consideration

as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3, 5, 7-9 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0887701 (EP'701).

A thermally processed image forming material containing a fatty acid silver salt has been known in EP'701. Note especially to page 2, lines 49-52; page 3, line 19-36; page 4, lines 35 to page 5, line 2; page 10, lines 43-45; page 12, line 19- 27; page 16, lines 35-49; page 20, lines 42-46; Tables 1-2 pages 27-29, Table 3, page 30-31. The organic silver dispersion was made from behenic acid and stearic acid. The material of EP'701 and that of the present claimed invention contains same fatty acid made with similar

process. Accordingly, the invention as claimed lacks novelty. Alternatively, it would have been prima facie obvious to the worker of ordinary skill in the art to use a known process of forming fatty acid silver to provide an invention as claimed. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP'701 as applied to claims 1, 3, 7-8 above, and further in view of WO97/34196 (WO'196) and EP'433.

The nucleating agent in claim 10 has been known in EP'433 on pages 6-13 and WO'196 on page 5. It would have been obvious to the worker of ordinary skill in the art to improve the image contrast of the material of EP'701 by incorporated therein the nucleating agent taught in WO'196 or EP'433 to provide the invention as claimed.

6. Claims 4, 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either EP'021433 (EP'433) or WO 97/341196 (WO'196).

The WO'196 on page 37, claim 1 and EP'433 on page 42, claim 1 disclose a material having composition similar to that of the claimed invention. The material contains a silver salt of aliphatic carboxylic silver salt, a reducing agent and a nucleating agent

having formula claimed in the present claimed invention. Note to WO'196 on page 33 formulation A wherein the material contains isoxazole co-developer and silver behenate; and EP'433 on pages 34-36, Example 2 wherein the organic silver salt made form silver salt made form aliphatic carboxylic acid, and nucleating agent of the claimed invention. The EP'433 and WO'196 may not disclose the process of making the silver salt of aliphatic carboxylic acid at an operation pressure of 1,800 kg/cm^2 presented in the claimed invention, but this limitation is related to the process of preparing silver salt of aliphatic carboxylic acid which fails to differentiate between the claimed material and that of the prior art of record. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). Accordingly, the claimed material is either anticipated or would have been found obvious to the worker of ordinary skill in the art in the absence of showing otherwise.

Response to Arguments

7. Applicant's arguments filed July 28, 2003 and the Declaration under 37 CFR 1.132 filed August 18, 2003 have been fully considered but they are not persuasive for the reasons presented in the rejection and the Response to Arguments set forth in the office action dated January 27, 2003, paper # 15. The supplemental under 37 CFR 1.132 filed August 18, 2003 fails to overcome the rejections. The silver salt of an

organic acid of sample 1 in the Declaration made according to the organic silver salt A taught in EP'701. This organic silver salt is a composition of silver behenate and silver stearate (e.g. made form 40 g of behenic acid and 7.3 g of stearic acid). The organic silver salt B of samples 2-3 of the Declaration made according the organic silver salt B shown on page 80 of the specification. This organic silver salt made of silver behenic acid (see page 77 of he specification). Therefore, it is improper to conclude as to whether the claimed material is not anticipated by or found unobvious over the EP'701. The scope of the claimed invention encompasses the scope the organic silver salt of EP'701, which contains a composition of silver behenate and silver stearate. See the language in the claim "non-photosensitive fatty acid silver salt grains" which include the combination of fatty acid such as behenic acid and silver stearic acid. The issue in the case is whether the organic silver salt of EP'701 is different from that of the EP'701 or provide a results that would have been found unexpected results to the worker of ordinary skill in the art when made accordingly to the process used in the claimed invention. Since the composition of the silver salt of an organic acid is different, one cannot determine the advantage of the process used in the claimed invention. The spectral sensitizing dye use in the Declaration is different from that containing in the samples of the EP'701, and the applicants stated that he believed that the samples 2-3 show the unexpected improvement regardless of the sensitizing dye associated therewith. This assertion is not persuasive in the absence of providing the data associated therewith. Also, the different between the value of haze, fog and sensitivity,

and sensitivity of the inventive sample and the comparative sample is within the limit of error range, and this improvement of results is not found unexpected.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea
September 26, 2003

Thorl Chea
Primary Examiner
Art Unit 1752